



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,609	06/18/2001	W. Radford Harrell	42519/235889	3302

826 7590 06/08/2005

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

GRAYSAY, TAMARA L

ART UNIT PAPER NUMBER

3623

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,609

Applicant(s)

HARRELL ET AL.

Examiner

Tamara L. Graysay

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) (2 pages).
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Drawings

2. The drawings are objected to because of the following:
 - a. They fail to comply with 37 CFR 1.84(p)(4) because reference character "28" has been used to designate both "databases" (Fig.2, upper right quadrant) and "screen display device" status (Fig.2, bottom center).
 - b. Further, if the reference character for "databases" is changed, it needs to be added to the specification (note p.6, line 8).
 - c. They fail to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 32 (Fig.3, left center); 64 (Fig.5).

Art Unit: 3623

- d. Figure 5, the box “verify identification information” should be designated with reference character 69 (see page 18, line 12), because 68 is used for the input identification information box.
 - e. Figure 5, the question at decision box 62 is “new member?” however the NO path is depicted for creating a developer profile. The description in the specification uses, for lack of a better word, an oppositely answered question at page 17, lines 5-9. Specifically, the decision mentioned in the specification is “whether the developer has established an developer profile?” which when answered NO would proceed to box 64. The examiner recommends using a description in the specification that is consistent with the depiction in the figures.
 - f. Figure 5, reference character 120 is used to depict the request level-two profile, however, the specification mentions reference character 115 for the same element.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore,
- a. the use of information obtained from a database remote from the innovation marketplace server, as recited in claims 3 and 13,
 - b. the associating a time and date stamp, as recited in claims 5 and 15,
 - c. the receiving additional knowledge capital from at least one innovator interface, as recited in claims 4 and 14,
 - d. storing knowledge capital on at least one server remote from the innovation marketplace server, as recited in claims 5 and 15,

Art Unit: 3623

- e. receiving knowledge capital comprising a unique digital signature, as recited in claims 8 and 18,

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The disclosure is objected to because of the following informalities:

- a. Page 3, lines 14 and 25, appear to contain typographical or grammatical errors.

Specifically, Each of the invention profiles is parsed into at least two or more sub-profiles (the underlined term is used also at page 14 last line), and the identity may be verified (typographical error).

- b. Page 5, line 17, "14"(second occurrence) should be 10.

Art Unit: 3623

- c. Page 6, line 5, "of" (first occurrence) should be or.
- d. Page 6, line 25, "12" (second occurrence) should be 16.
- e. Page 8, line 29, "inventor" should be innovator for consistency.
- f. The use of acronyms is acceptable, however, the acronym should be spelled out at least at its first occurrence: CPA and IPO (page 13, line 20).
- g. Page 21, line 1, "developer" should be innovator for consistency because it is the innovator that grants or denies permission to the developer for full-disclosure.
- h. Page 27, line 1, "of" should be or.
- i. Page 27, line 3, "of" (first occurrence) should be or.

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter recited in claim 10 (and 20) does not have proper antecedent basis. Although the monetary payment barrier to entry at level two is provided for in the specification (e.g., preset fee page 20, line 14), the contractual obligation is not mentioned in the specification as a barrier to entry at the second-level profile.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3623

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8, 10-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US-5862223).

Regarding claim 1, Walker discloses a method comprising:

receiving knowledge capital information at the innovation marketplace server from at least two innovator interfaces defining a plurality of innovation profiles

- The knowledge capital is in the form of detailed qualifications of an expert (i.e., innovator) as mentioned at col.8, lines 16-22.
- The disclosure mentions plural "experts" throughout, which infers at least two innovators. The preamble recites an innovator interface, yet the body of the claim receives information from at least two innovator interfaces, so the claim has been interpreted to mean at least two innovators provide the information referred to in the receiving step. If the claim, in the alternative, were to be interpreted to include more than one innovator interface, such a modification of the process to include receiving information from plural interfaces is an obvious expedient for a system, like the information Exchange disclosed in Walker in order to accommodate a experts (innovators) at remote or global locations.

dividing each of the plurality of innovation profiles into at least two sub-profiles having differing levels of information

- The information that is received from the expert (innovator) is divided into at least two levels of information as mentioned in the example at col.8, lines 5-8 wherein names but not location or phone number is provided. Similarly, the information about payment (billing method and/or payment type) would be confidential from the other party in most cases, insofar as the program processes payment to the seller in the manner preferred by the receiver and from the buyer in the manner preferred by the seller.

storing the sub-profiles in at least one database associated with the innovation marketplace server

- The information is stored at the Exchange database for access as mentioned at col. 6, lines 16-21.

Art Unit: 3623

searching the database to determine to determine a match of the first sub-profiles to search criteria

- The user (developer) can search the database for experts (innovators) by certain criteria (characteristics) as mentioned at col. 6, lines 16-21.

displaying at least one first sub-profile in response to a match between the first sub-profile and search criteria provided by the developer

- The monitor (430, 530) is a display as mentioned at col. 16, lines 1-44.

providing access to the second sub-profile in response to satisfaction of an access a barrier

- The embodiment discussed with regard to figures 17-18 for example requires payment information to be provided by the user (developer) before contact with the expert (innovator) is made in order to bill the user for the time spent during the exchange of information (second sub-profile level of information) between the expert and user, i.e., the billing period.

Regarding claim 2, Walker further discloses receiving information identifying an innovator of the knowledge capital as mentioned at col. 8, line 7.

Regarding claim 3, Walker further discloses verifying the identity of an innovator, as mentioned at col. 6, line 35. Using outside databases is described at col. 7, lines 34+; inherently the use of an outside database to locate an expert (innovator) would include verifying the expert's identity.

Regarding claim 4, Walker fails to disclose the storing information in different databases.

However, the examiner takes official notice that the use of separate databases is a well known expedient to ensure the integrity of the information stored in each database from accidental or

Art Unit: 3623

intentional access by unauthorized persons. Therefore, it would have been obvious to one of ordinary skill in the art to modify the process of Walker to include storing information on separate databases to ensure the integrity of the information and prevent persons from unauthorized access to the information.

Regarding claim 5, Walker further discloses associating a time stamp with the information provided by the expert (innovator). It would have been obvious to not only include the time but the date as well in order to fully note when the information was received.

Regarding claim 6, Walker further discloses an option of receiving additional information as mentioned in the example at col. 39, lines 4-26, whereby the developer (user) can modify the information provided. Walker does not specifically disclose an embodiment where the process includes receiving additional information from the innovator (expert) and associating the additional information with a different date and time stamp. However, Walker does disclose a process where the requester can change the information requested as mentioned at co.39, lines 4-26. When the requester (developer) changes the information that is requested, it would follow that the information provided by the expert (innovator) would be changed as well, for price and/or content. Providing a date and time stamp would ensure that the most current information is readily available.

Regarding claim 7, Walker fails to disclose the storing information in different databases.

However, the examiner takes official notice that the use of separate databases is a well known

Art Unit: 3623

expedient to ensure the integrity of the information stored in each database from accidental or intentional access by unauthorized persons. Therefore, it would have been obvious to one of ordinary skill in the art to modify the process of Walker to include storing information on separate databases to ensure the integrity of the information and prevent persons from unauthorized access to the information.

Regarding claim 8, Walker further discloses receiving information using a digital signature indicating the author as mentioned at col. 10, lines 27+.

Regarding claim 9, Walker further discloses payment by the developer (user) before additional information is provided about the expert (innovator) second sub-profile access (fees, responses, etc.).

Regarding claim 10, by agreeing to pay for the information that will be provided by the expert (innovator) the user (developer) has entered into a "contractual" obligation, as broadly recited, insofar as a "contractual" obligation need not be written, but only have the nature of a contract and payment for services is in essence a contractual obligation.

Regarding claims 11-20, the system is depicted at figures 1-5 including an innovator interface (expert interface 400), a developer interface (user interface 500), a network (110), and an innovation marketplace (central controller 200 includes the Exchange). The structure is used in

Art Unit: 3623

the manner claimed (e.g., the wherein clause of claim 11 and the functionality recited in dependent claims 12-20), as discussed with regard to method claims 1-10 above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Collins (WO-200126002-A1) teaches the use of a searchable database for storing unpublished technology information that may be available for licensing. The barriers to access include password protection, for example.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamara L. Graysay
Examiner
Art Unit 3623

05312005